Doc Code: AP.PRE.REQ

PTO/SB/33 (07/05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
112740-207

I hereby certify that this corespondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR

on February 3, 2006

Signature

Typed or printed name Renee Street

Application Number	Filed
09/827,487	August 9, 2001

First Named Inventor: Thomas Brumm et al.

Art Unit	Examiner
2661	Michael J. Moore, Jr.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 48,196
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34

Signature

Peter Zura
Typed or printed name

312-807-4208
Telephone number

February 3, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [x] *Total of 1 forms are submitted.

Doc Code: AP.PRE.REQ

PTO/SB/33 (07/05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 112740-207

I hereby certify that this corespondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR

on February 3, 2006

Signature

Typed or printed name Renee Street

Application Number	Filed
09/827,487	August 9, 2001

First Named Inventor: Thomas Brumm et al.

Art Unit	Examiner
2661	Michael J. Moore, Jr.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 48,196
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34

Signature

Peter Zura
Typed or printed name

312-807-4208
Telephone number

February 3, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [x] *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Thomas Brumm et al.
Appl. No.:	09/827,487
Conf. No.:	5738
Filed:	August 9, 2001
Title:	SYSTEM FOR CONNECTING TELECOMMUNICATION EQUIPMENT TO A PACKET-SWITCHING TELECOMMUNICATION NETWORK
Art Unit:	2661
Examiner:	Michael J. Moore, Jr.
Docket No.:	112740-207

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated August 3, 2005, and Advisory Action dated November 29, 2005. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 1 and 3-27 are pending in the present application. Claims 1, 21, 24 and 26 were amended in this response to correct minor informalities. No new matter has been introduced as a result of the amendment.

Claims 1 and 3-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Rose* et al. (US Patent 6,396,840) in view of *Ress et al.* (US Patent 6,885,658).

The cited art, alone or in combination, does not disclose the use of first and second signaling data, respectively coupled to packet-switched and line-switched communications network "wherein the second signaling data [*of the line-switching communication network*] is transmitted in the packet-switching communications network instead of the first signaling data [*of the packet-switched communication network*] when the second signaling data cannot be converted to the first data" as recited in claim 1, and similarly recited in claims 21, 24 and 26.

The Office Action conceded that *Rose* fails to teach the aforementioned limitations. However, the Office Action then erroneously relies upon the teaching of *Ress* to formulate the obviousness rejection. *Ress* discloses interworking agents that communicate with each other according to a protocol independent format referred to as the "agent interworking protocol" (AIP). The agent interworking protocol represents a superset of the messaging capabilities of all protocols to be supported within the packet network (col. 6, lines 21-37). The agent networking protocol is used by the system of *Ress* to transfer message data (SIP, MGCP, H.323), and not signaling information, according to a mapped protocol. In col. 9, lines 2-30, *Ress* discloses that the internetworking relates to the protocol of the message (H.323) that is tunneled (i.e., not converted), and not the signaling (H.245). The agent of *Ress* checks to see if the specific signaling is available, and if so, transfers the message data in a converted or native format – if the signaling is not supported, the data is simply discarded (col. 10, lines 35-41).

Regarding the Advisory Action, Applicant concedes that Ress generally discloses signaling between the agents and a MGCP gateway (col. 11, lines 59-67). However, the disclosure relied upon by the Examiner does not teach the optional (i.e. second instead of the first) sending of signaling data when line switched signaling data (second signaling data) cannot

be converted to packet-switched data (first signaling data). In fact, the entire disclosure of Ress is premised in the exchange of IP telephony protocols – line-switched signals are not even addressed. Furthermore, the H.245 signaling disclosed in col. 9, lines 17-30 merely discloses that message tunneling using H.245 signaling is accomplished by sending "H.245 indications" between two H.323 devices, where the H.245 signaling indicates terminal capabilities of the endpoint, and the agent acknowledges the message (i.e., the message goes through, see col. 12, line 57 – col. 13, line 6). The H.245 terminal capability messages and the AIP CPG messages are then combined into a multipart message, where if one or the other message protocols are not supported, they will be discarded (col. 13, lines 1-6). This disclosure cannot be interpreted as meaning that the H.245 message is being converted to AIP CPG messages to establish optional transmission. Furthermore, as discussed previously, both the H.245 message and AIP CPG messages as relied on in the embodiments cited by the examiner are transmitting in the packet-switched network (col. 6, lines 44-51).

Moreover, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Rose* and *Ress* references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must exp*Ress*ly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain

why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

As discussed above, the *Ress* reference the disclosure contemplates the use of a protocol-independent agent interworking protocol to correlate disparate protocols being used across a gateway to ultimately provide a protocol-neutral system. In contrast, Rose is specifically directed to routing calls between narrow-band and broad-band ISDN, and further provides already-translated messaging and signaling (col. 8, lines 22-36; col. 9, lines 6-22). There is simply no teaching, suggestion or motivation for one having ordinary skill in the art to rely on the teaching in *Ress* when considering the teaching of *Rose*. In fact, there is no provision in *Rose* whatsoever that would suggest the use of a protocol-neutral configuration or AIP messaging such as that taught in *Ress*, without relying on impermissible hindsight. Moreover, it is not understood how a configuration such as that in Ress would even be incorporated into the teaching of Rose.

In light of the above, Applicant respectfully submits that claims 11-20 of the present application are both patentable over the art of record, and respectfully requests that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Office is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-207) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY _____
Peter Zura
Reg. No. 48,196
Customer No.: 29177
Phone: (312) 807-4208

Dated: February 3, 2006